

### REMARKS

In the Office Action dated February 18, 2005, claims 65 and 66 were objected to; claims 49, 54, and 69 were rejected under 35 U.S.C. § 112, ¶ 1; claims 49-71 were rejected under § 112, ¶ 2; claims 49 and 53 were rejected under § 102 over each of U.S. Patent No. 6,567,190 (Reele) and 6,608,707 (Han); claims 50-52 were rejected under § 103 over Han in view of U.S. Patent No. 6,642,943 (Machida); claims 54-58, 60-69, and 71 were rejected under § 103 over Han in view of U.S. Patent No. 6,556,875 (Nagasaka); claim 59 was rejected under § 103 over Han and Nagasaka in view of U.S. Patent No. 5,862,321 (Lamming); and claim 70 was rejected under § 103 over Han and Nagasaka in view of Machida.

### CLAIM OBJECTIONS

Claim 65 has been amended to address the objections. Withdrawal of the objection is therefore respectfully requested. Claim 66 has been cancelled and thus this objection has been rendered moot.

### REJECTIONS UNDER 35 U.S.C. § 112, ¶ 1

Each of claims 49 and 54 were rejected based on the language “user interface on a standalone scanner.” The Office Action stated that such a user interface on a standalone scanner is not described in the specification pursuant to § 112, ¶ 1.

Applicant respectfully disagrees. As described on page 5 of the present specification, the standalone scanner 16 “may include a keypad and a limited display” (*see* line 18). Thus, this provides a description that a display is included in the standalone scanner. Fig. 3B also shows that the scanner 16 is a scanner with optional keyboard and display. Fig. 3B also shows a display 66 connected to the scanner 16. Moreover, as depicted in Fig. 3B, a scan system 100 can be executed in the standalone scanner 16, and one implementation of the scan system 100 is a browser program. Specification, p. 7, lines 15-18. The present application also describes the scan system 100, which is executable in the standalone scanner 16, as executing a display ADF user interface process at step 104 in Fig. 4. Specification, p. 8, lines 4-7 (the display ADF user interface process is described in detail with respect to Fig. 5 of the present application). The display user interface process 120 depicted in Fig. 5 refers to displaying available servers, and displaying icons representing available folders. *See* Specification, p. 8, line 14-p. 9, line 16. The

specification also describes that the scan system 100, executable in the scanner 16, can execute a document drag-and-drop process at step 105 of Fig. 5. Specification, p. 8, lines 8-9. Thus, it is clear based on the written description provided in the present specification that, according to at least one embodiment, the scan system 100 executable in the scanner 16 (depicted in Fig. 3B) is able to provide a user interface (as provided by the display ADF user interface process and/or document drag and drop process) on the scanner with optional keyboard and display 16 (Fig. 3B) or on an attached display 66. The language "user interface of the standalone scanner" in claim 49 or 54 can refer to the user interface presented in the display included in the scanner 16 or the external display 66. Withdrawal of the § 112, ¶ 1, rejections of claims 49 and 54 is respectfully requested.

Claim 69 has been cancelled to render the § 112, ¶ 1, rejection of the claim moot.

#### REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

The term "standalone scanner" used in the claims was rejected as being indefinite. Applicant respectfully disagrees with the assertion that the term "standalone" renders the claims indefinite. The term "standalone" used in the scanner context has a well understood meaning. In fact, one of the references cited by the Office Action, Han, uses the term "stand-alone" to refer to scanners. Also, Applicant has attached a dictionary definition of the term "stand-alone," from the Merriam-Webster On-Line Dictionary, that defines "stand-alone" as "self-contained; especially: operating or capable of operating independently of a computer system." This definition, well understood by persons of ordinary skill in the art, is consistent with the use of the term "stand-alone" in the specification of the present application. Therefore, in view of the well understood meaning of the term "stand-alone," it is respectfully submitted that "standalone scanner" as used in the claims does not render the claims indefinite.

Withdrawal of the § 112, ¶ 2, rejection is respectfully requested.

#### REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

It is respectfully submitted that amended independent claim 49 is not anticipated by either Reece or Han. Amended claim 49 recites a method of transferring an image to a destination, that comprises accessing, by a standalone scanner, at least one network device over a network; displaying destination options on a user interface of the standalone scanner *based on*

*accessing the at least one network device; and obtaining a destination based on selection in the user interface.*

In contrast, Reelee describes a scanner 100 that is connected to a printer 128 (*see* Figs. 1 and 2 of Reelee). A scanned image can be transmitted to the printer 128. Reelee, 3:58-62. Also, Reelee states that communication software can be added to the scanner 100 to allow the operator to *view images* downloaded *from* the Internet. Reelee, 4:37-40. This indicates that the scanner 100 that receives images for viewing from the Internet, but does not teach the transferring of images over the Internet to a destination.

Although no written description was provided in Reelee, Fig. 3 does show two boxes at the bottom of the figure that have the following legends: “Transmit to Internet?” and “Transmit to Internet.” It is unclear what is being transmitted, since Reelee provides absolutely no description regarding the two lower boxes of Fig. 3. In any event, Reelee clearly does not disclose its scanner accessing at least one network device over a network, displaying destination options on a user interface of the standalone scanner *based on accessing the at least one network device*, and obtaining a destination based on selection of the destination options in the user interface.

Therefore, claim 49 is not disclosed by Reelee.

Han also fails to disclose the subject matter of amended claim 49. The primary embodiments of Han refer to storing a scanned image to a disk. However, in one embodiment, Han does describe transmitting files over a network to a specific work station for later use (Han, 11:14-15), or transmitting images via an Ethernet port to a network (Han, 12:8-11), or sending an image via e-mail over a network (Han, 12:22-23). However, there is no teaching in Han of its standalone scanner accessing a network device over a network and displaying destination options on a user interface of the standalone scanner based on accessing the network device. Nor does Han describe obtaining a destination based on selection of the destination options in the user interface.

Han therefore does not anticipate claim 49.

Independent claim 54 was rejected as being obvious over Han and Nagasaka. The Office Action conceded that Han does not disclose a drag-and-drop operation where a first displayed element associated with a scanner is dragged-and-dropped to another element (a selected one of

the icons as recited in claim 54). 2/18/2005 Office Action at 9. However, Han relies upon Nagasaka as teaching the missing element.

Applicant respectfully submits that a *prima facie* case of obviousness cannot be established with respect to claim 54 over Han and Nagasaka for at least the following reasons: no motivation or suggestion existed to combine the teachings of Han and Nagasaka; and even if combined, the references do not teach or suggest *all* elements of the claim. See M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 2), at 2100-129.

Amended claim 54 recites computer readable program code being executable on a *standalone scanner* to: query at least one network device over a network for folders; display icons representing the folders in a user interface of the standalone scanner; and in response to a first display element being dragged to and dropped upon a selected one of the icons, causing the standalone scanner to scan at least one image, and transferring the at least one image from the standalone scanner to a folder associated with the selected one of the icons.

Neither Han nor Nagasaka describes or even suggests querying at least one network device over a network for folders, and displaying icons representing the folders in a user interface of the standalone scanner. Although Han mentions the transfer of images to a network, Han does not provide any suggestion of the querying or displaying tasks of claim 54.

Nagasaka also fails to teach or suggest these elements. Nagasaka describes an application unit 20 (Fig. 1) that is able to control transfer of data from a scanner to a printer. Nagasaka, 7:1-7. A “concrete” embodiment of the computer that contains the application unit is depicted in Fig. 21. Nagasaka, 19:44-45. In Fig. 21, a computer 100 is connected to a computer 200 (which is connected to a printer 240), and to a computer 300 (which is connected to a scanner 340). Nagasaka, 19:50-58. The application unit that is executed on the computer provides a Cyber Copy program to implement a virtual copy machine so that data can be transferred from a scanner to a printer. Nagasaka, 18:40-43. Nagasaka has several shortcomings with respect to the claimed subject matter. Although Fig. 23 of Nagasaka shows scanner and printer icons, there is nothing in Fig. 23 or anywhere else in Nagasaka teaching that the application unit is able to query a network device over a network for folders, and displaying icons representing the folders in a user interface of a standalone scanner. Moreover, the application unit of Nagasaka is executed on a computer, not on a standalone scanner.

In view of the foregoing, because neither Han nor Nagasaka teaches or suggests all elements of claim 54, a *prima facie* case of obviousness cannot be established.

Moreover, there existed no motivation or suggestion to combine the teachings of Han and Nagasaka. Han states that its purported invention “eliminates the need for having a computer operatively connected thereto [a scanner] during the scanning process.” Han, 3:36-37. In contrast, Nagasaka teaches that Nagasaka’s application unit that provides the Cyber Copy feature of copying from a scanner to a printer is executed on a computer 100 (*see* Fig. 21 of Nagasaka). In other words, Han teaches away from the implementation described in Nagasaka. Because Han teaches away from the solution proposed by Nagasaka, no motivation or suggestion existed to combine the teachings of Han and Nagasaka.

In view of the foregoing, it respectfully submitted that a *prima facie* case of obviousness cannot be established with respect to Han and Nagasaka.

Newly added independent claim 81 is similarly allowable.

Amended independent claim 62 is also allowable over the asserted combination of Han and Nagasaka. As conceded by the Office Action, Han does not disclose at least the browser program element of claim 62. 2/18/2005 Office Action at 14. Reliance was made on Nagasaka as teaching the missing element.

It is respectfully submitted that Han does not disclose the following elements of amended claim 62: a browser program stored in the memory for accessing a network device on the network; a display for displaying destination locations on the network device; and a user interface to enable selection of one of the destination locations (on the network device) for causing the standalone scanner to scan an image and automatically send the scanned image to the selected one of the destination locations on the network device.

Nagasaka also fails to teach or suggest the missing elements. Although Nagasaka teaches a user interface that can display printer and scanner icons (*see* Fig. 23 of Nagasaka), Nagasaka fails to teach a browser program for accessing a network device, a display for displaying destination locations on the network device, and a user interface to enable selection of one of the destination locations.

Therefore, the hypothetical combination of Han and Nagasaka does not teach or suggest all elements of claim 62. Also, as discussed further above, no motivation or suggestion existed


to combine the teachings of Han and Nagasaka. Therefore, claim 62 is allowable over Han and Nagasaka.

Dependent claims, including newly added dependent claims 72-80 and 82, are allowable for at least the same reasons as corresponding independent claims. In view of the allowability of amended base claims over the cited references, it is respectfully submitted that the obviousness rejections of claims 50-52, 59, and 70 have been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10001122-1).

Respectfully submitted,

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**Main Entry: stand-alone**   
 Pronunciation: 'stan-d&- 'lOn  
 Function: *adjective*  
 : **SELF-CONTAINED**; *especially* : operating or capable of operating independently of a computer system <a *stand-alone* word processor>

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